

REMARKS

As a preliminary matter, Applicants appreciate the Examiner's indication that dependent Claims 10-13 and 19 contain allowable subject matter, and would be allowed if amended into independent form. However, in light of the arguments made below, Applicants have opted not to amend Claims 10-13 and 19 into independent form at this time.

Claims 1-5 stand rejected under 35 U.S.C. §102(b) as being anticipated by United States Patent No. 1,962,518 to Nessler. Applicants also believe that the Examiner intended to include Claim 6 in this rejection (because the "hook portion" of Claim 6 is also mentioned in the rejection). Accordingly, Applicants will respond as though the rejection included Claim 6. Applicants respectfully traverse this rejection.

Applicants respectfully submit that the Nessler reference fails to disclose all of the features of the present invention. More specifically, the Nessler reference fails to disclose a tibial sizer that includes, *inter alia*, "a channel extending along said tibial sizer in a longitudinal direction, through at least a portion of said head and at least a portion of said handle," as defined in Claim 1.

First of all, Applicants respectfully submit that the portion of the device of Figure 1 of the Nessler reference that the Examiner equated with the claimed channel (the portion supporting sliding gate 5) does not extend "in a longitudinal direction," as defined in Claim 1, but instead extends in a *transverse direction* with respect to the entire device. Applicants' Figure 2 shows one example of an embodiment of a device defined by Claim 1,

and it can be clearly seen that channel 34 extends in the *longitudinal direction* of sizer 10. In contrast, in Figure 1 of the Nessler reference, the portion supporting sliding gate 5 extends in the transverse direction of the device, which direction is actually perpendicular to the claimed longitudinal direction. For at least this reason, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 1 and associated dependent Claims 2-6.

Additionally, Applicants respectfully submit that the portion of the device of Figure 1 of the Nessler reference that the Examiner equated with the claimed channel (the portion supporting sliding gate 5) also fails to extend “through at least a portion of said head and at least a portion of said handle,” as also defined in Claim 1. Applicants’ Figure 2 shows one example of an embodiment of a device defined by Claim 1, and it can be clearly seen that channel 34 extends through at least a portion of the head 12 and at least a portion of the handle 14.

In contrast, the device of Figure 1 of the Nessler reference lacks a channel that extends through at least a portion of both the head and the handle, as defined in Claim 1. In the Office Action, the Examiner appears to have equated thin plate 1 of Figure 1 of the Nessler reference with the claimed head, and to have equated bracket 6 with the claimed handle. However, the hollow portion of bracket 6 (which the Examiner appears to have equated with the claimed channel) does not extend through at least a portion of thin plate 1, as recited in Claim 1. Applicants respectfully submit that there is no portion of thin plate 1

that can be considered as the claimed “channel” because this component lacks a long gutter or groove within which the slider is configured to be slidably positioned. Instead, prong 3 of plate 1 is merely a thin plate, without any channel. Thus, for at least this reason also, Applicants respectfully request the withdrawal of this §102(b) rejection of independent Claim 1 and associated dependent Claims 2-6.

Applicants also separately traverse dependent Claim 5 because the device of Nessler lacks a head with posterior, lateral and medial outward peripheral surfaces that correspond to similar surfaces of a tibial base plate of a unicompartmental knee prosthesis. The device of Nessler is a hair gathering device, and has nothing to do with a knee prosthesis, or even with orthopedic implants in general. Accordingly, there is no disclosure in the Nessler reference that thin plate 1 should be shaped to correspond to a tibial base plate. Accordingly, for this reason also, Applicants respectfully request the withdrawal of this §102(b) rejection of dependent Claim 5.

Claims 1, 7-9 and 12 stand rejected under 35 U.S.C. §103 as being unpatentable over United States Patent No. 2,531,477 to Smith in view of United States Patent No. 6,979,299 to Peabody et al. Applicants respectfully traverse this rejection.

Applicants respectfully traverse this rejection because: (1) Applicants respectfully submit that one of ordinary skill in the art would not have combined Peabody et al. with Smith; and (2) even assuming *arguendo* that the Examiner’s proposed combination

was proper, the resulting device still fails to include all of the claimed features of the present invention.

First, Applicants respectfully submit that one of ordinary skill in the art would not have combined Peabody et al. with Smith because the two devices are used in different areas, and an artisan skilled in one area would not be familiar with the other area. The device of Smith is intended to be used in a shoe store for measuring feet to provide an indication of the proper shoe size. In contrast, the device of Peabody et al. is to be used by an orthopedic surgeon during surgery to make necessary bone measurements, and to mark the bone to facilitate location of a prosthesis. Thus, the devices of Peabody et al. and Smith are used by different groups of people (orthopedic surgeons vs. shoe salespeople); by people of different skill levels; for measuring different areas (bones, such as femurs, vs. feet); in different environments (operating room vs. shoe store); and for different purposes (to determine bone length and provide a mark for implanting a prosthesis vs. to determine appropriate shoe size). Thus, due to all these differences, Applicants respectfully submit that one of ordinary skill in the art of selling shoes would not have looked to a measuring guide for use in an orthopedic implant procedure to modify a device for determining proper shoe size. Accordingly, for at least this reason, Applicants respectfully request the withdrawal of this §103 rejection of Claims 1, 7-9 and 12 under the combination of Smith and Peabody et al.

Secondly, even assuming *arguendo* that Peabody et al. could be combined with Smith, the resulting combination still fails to include all of the features of Claim 1, as

amended. More specifically, the references of the proposed combination of Smith and Peabody et al. fail to disclose or suggest a tibial sizer that includes, *inter alia*, a channel and “a slider configured and arranged to be slidably positioned within said channel, such that said slider is slidable within both said head and said handle,” as defined in amended independent Claim 1.

In the Office Action, the Examiner equated rod 22 of the Smith device with the claimed slider. He also equated opening 32 with the claimed channel, container 12 with the claimed head, and portion 42 of plate 20 with the claimed handle. However, Applicants respectfully submit that rod 22 of Smith cannot be considered as the claimed slider because it is not configured and arranged to be slidably positioned within opening 32 (which the Examiner equated with the claimed channel). Nor is rod 22 configured to be slid within any other component that could be considered as the claimed channel. In contrast, rod 22 of Smith is rigidly secured to container 12, and does not slide relative to the container. *See* Smith, col. 2, lines 5-7. Thus, rod 22 of Smith does not satisfy the features of Claim 1 that define the claimed slider.

Additionally, Applicants also respectfully submit that arm 28 of Smith cannot be considered as the slider defined in Claim 1 either. Although arm 28 is slidable within container 12 (which the Examiner equated with the claimed “head”), it is not slidable within plate 20 (where the Examiner equated portion 42 of plate 20 with the claimed “handle”). Instead, arm 28 is securely mounted to plate 20 via collar 38. Thus, arm 28 is not slidable

within any component that could be considered as the claimed handle. Accordingly, all of the features of Claim 1 are not satisfied by Smith (amended Claim 1 recites that the slider is “slidable within both said head and said handle”). Further, the Peabody et al. reference does not remedy this deficiency, nor was it relied upon as such by the Examiner. Accordingly, as all of the features of amended independent Claim 1 are not discussed or suggested in either Smith or Peabody et al., Applicants respectfully request the withdrawal of this §103 rejection of independent Claim 12 and associated dependent Claims 7-9 and 12.

Claims 17 and 18 stand rejected under 35 U.S.C. §103 as being unpatentable over United States Patent No. 1,962,518 to Nessler in view of United States Patent No. 4,211,228 to Cloutier. Applicants respectfully traverse this rejection.

Applicants respectfully traverse this rejection because: (1) Applicants respectfully submit that one of ordinary skill in the art would not have combined Nessler with Cloutier; and (2) even assuming *arguendo* that the Examiner’s proposed combination was proper, the resulting device still fails to include all of the claimed features of the present invention.

First, Applicants respectfully submit that one of ordinary skill in the art would not have combined Cloutier with Nessler because the two devices are used for different purposes, and an artisan skilled in one area would not be familiar with the other area. The device of Nessler is intended to be used to determine the volume of hair grown in a certain region of the scalp. In contrast, the device of Cloutier is to be used by an orthopedic surgeon

during surgery to determine the location of a tibial prosthesis component. Thus, the devices of Cloutier and Nessler are used by different groups of people; by people of different skill levels and areas of expertise; for measuring different areas (a resected tibia vs. hair); in different environments; and for different purposes (to determine the location of a tibial component of a prosthesis vs. determining the volume of hair in a specific area of the scalp size). Thus, due to all these differences, Applicants respectfully submit that one of ordinary skill in the art of would not have looked to the tibial template of Cloutier to modify the hair measuring device of Nessler. Accordingly, for at least this reason, Applicants respectfully request the withdrawal of this §103 rejection of Claims 17 and 18.

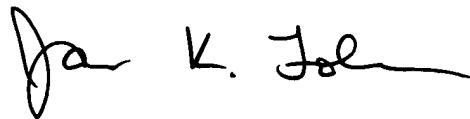
Secondly, even assuming *arguendo* that Cloutier could be combined with Nessler, the resulting combination still fails to include all of the features of independent Claim 17. More specifically, the references of the proposed combination of Nessler and Cloutier do not disclose or suggest a system of tibial sizers, where each sizer includes “a channel extending along said tibial sizer in a longitudinal direction, through at least a portion of said head and at least a portion of said handle,” as defined in independent Claim 17. In the section responding to the §102(b) rejection of Claims 1-6 under Nessler, Applicants discussed how the Nessler reference lacks this feature. Additionally, the Cloutier reference does not include this feature either, nor was it relied upon as such by the Examiner. Accordingly, for this reason also, Applicants respectfully request the withdrawal of this §103 rejection of independent Claim 17 and associated dependent Claim 18.

For all of the above reasons, Applicants request reconsideration and allowance of the claimed invention. Should the Examiner be of the opinion that a telephone conference would aid in the prosecution of the application, or that outstanding issues exist, the Examiner is invited to contact the undersigned.

Respectfully submitted,

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